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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/721,432	11/25/2003	Virgil A. Albaugh	AUS920030683US1	7145
45971 7590 03/18/2008 IBM CORPORATION (RUS) c/o Rudolf O Siegesmund Gordon & Rees, LLP 2100 Ross Avenue Suite 2800 DALLAS, TX 75201				
EXAMINER				
COLBERT, ELLA				
ART UNIT		PAPER NUMBER		
3696				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/721,432

**Applicant(s)**

ALBAUGH ET AL.

**Examiner**

Ella Colbert

**Art Unit**

3696

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 November 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-76 is/are pending in the application.
- 4a) Of the above claim(s) 16-38 and 54-76 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 and 39-53 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB-08)  
Paper No(s)/Mail Date 11/25/03.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application.
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. Claims 1-76 are pending. Claims 1-15 and 39-53 in Group I have been elected without traverse and Claims 16-38 and 54-76 have been withdrawn in response to the Election/Restriction filed 11/20/07. Claims 1-15 and 39-53 will be examined on the merits. The IDS filed 11/25/03 has been considered.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 and 39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is indefinite because there are not enough method steps to determine what Applicants' are inventing.

Claim 39 recites "... to perform steps comprising:". There is only one step in the body of the claim. "Steps" is plural, meaning more than one step. Claims 2-15 and 40-53 are also rejected for their dependency on a rejected base claim.

#### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1 and 39 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 1-15 and 39-53 are drawn to a method

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and system for processing a plurality of records into a metric using a composition rule with the records and metric in the same format. It is unclear how the objective of processing the plurality of records into a metric using a composition rule with the records and the metric being in the same format" by the Applicants' is achieved in the claim language because the first claim limitation in claim 1 recites "...processing the plurality of records into a metric using a composition rule with the records and the metric being in the same format". In fact, "processing the records" or even its equivalent is not mentioned in the body of claims 1 and 39. Claims 1-15 can be performed in the mind or with a pencil and paper. Claim 39 hints at being performed on a computer but does not produce a concrete, useful or tangible result. As such the claimed invention is directed to a judicial exception to 35 U.S.C. §101 (i.e. an abstract idea, natural phenomenon, or law of nature) and is not directed to a practical application of such judicial exception because the claims do not require any physical transformation and the invention as claimed does not produce a useful, concrete, and tangible result.

Useful- must be specific, substantial and credible and specifically recited in the claim. If the claim is broad enough to not require a practical application, it must be rejected.

Tangible- must be some "real-world" result, not abstract.

Concrete - must have a result that can be substantially repeatable or the process must substantially produce the same result again. Claim 1 does not produce tangible results, but merely processing records into a metric using a composition rule. These processing of the records and the conversion into a metric using a composition rule might remain entirely inside the mind of the person doing the processing of the records. These results are not tangible, thus not eligible subject matter, thus are rejected.

Similarly converting records into a metric using a composition rule does not produce a real-world result unless further action is taken. The records and the metric in the same

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format also fails to produce a real world-result without further action. Furthermore, Claims 1-15 and 39-53 do not necessarily affect the physical world. They lack a tangible and concrete result, and are rejected as non-statutory subject matter.

The Court of Appeals for the Federal Circuit issued opinions in *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 149 F. 3d 1368, 47 USPQ2d 1596 (Fed. Cir. 1998) and *AT & T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 50 USPQ2d 1447 (Fed. Cir. 1999). These decisions explained that, to be eligible for patent protection, the claimed invention as a whole must accomplish a practical application. That is, it must produce a "useful, concrete and tangible result." *State Street*, 149 F.3d at 1373-74, 47 USPQ2d at 1601 d2. To satisfy section 101 requirements, the claim must be for a practical application of the 101 judicial exception, which can be identified in various ways: (a) The claimed invention "transforms" an article or physical object to a different state or thing. (b) The claimed invention otherwise produces a useful, concrete and tangible result, based on the factors discussed below.

The USPTO's official interpretation of the utility requirement provides that the utility of an invention has to be (i) specific, (ii) substantial and (iii) credible. See MPEP § 2107. It is not clear as to what is the utility of processing records into a metric using a composition rule because there is no assurance that this will result in the records and the metric being in the same format.

The tangible requirement does require that the claim must recite more than a § 101 judicial exception, in that the process claim must set forth a practical application of that § 101 judicial exception to produce a real-world result. *Benson*, 409 U.S. at 71-72, 175 USPQ at 676-77 (invention ineligible because had "no substantial practical

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application"). It is not clear as to what tangible result is produced by implementing the steps of the claim especially since there is no guarantee that implementing the steps of the claims will result in the records and the metric being in the same format.

For an invention to produce a "concrete" result, the process must have a result that can be substantially repeatable or the process must substantially produce the same result again. In re Swartz, 232 F.3d 862, 864, 56 USPQ2d 1703, 1704 (Fed. Cir. 2000) (where asserted result produced by the claimed invention is "irreproducible" the claim should be rejected under section 101). The opposite of "concrete" is unrepeatable or unpredictable.

There is no useful, concrete and tangible result produced from implementing the steps of the claimed invention. The dependent claims are rejected for the same reason and by way of dependency on a rejected independent claim.

***Claim Rejections - 35 USC § 102***

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6 and 39-44 are rejected under 35 U.S.C. 102(b) as being anticipated by (US 6,205,437) Gifford.

The rejection has been given to the best of the Examiner's ability considering the condition of the claims.

Claims 1 and 39. Gifford discloses, A method for processing a plurality of records into a metric using a composition rule wherein the records and the metric are in the same format (col. 5, lines 32-62).

Claim 39. Gifford discloses, A program product operable on a computer comprising: a computer-usable medium and wherein the computer usable medium comprises instructions for a computer to perform steps (col. 8, lines 8-11).

Claims 2 and 40. Gifford discloses, wherein the records are associated with a unit of work and the composition rule creates the metric from the records associated with the unit of work (col. 6, lines 6-51).

Claims 3 and 41. Gifford discloses, wherein one of the records is a sentinel record which contains an instruction to close the unit of work and apply the composition rule to the unit of work (col. 6, lines 52-65 and col. 8, lines 52-65).

Claims 4 and 42. Gifford discloses, wherein the composition rule comprises a record selection rule and the record selection rule selects the records from a database using the syntax: "Tag Name" = ("Field1" = "Value" and "Field2"= "Value2") (col. 6, lines 32-51 and col. 8, lines 12-44).

Claims 5 and 43. Gifford discloses, wherein the composition rule comprises instructions for aggregating a measurement value for the records, instructions for normalizing a field and an attribute within the records, and instructions for composing the metric (col. 8, lines 52-65).

Claims 6 and 44. Gifford discloses, wherein the format allows a processing engine to meter a plurality of on demand service resources (col. 8, lines 16-29).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7-15 and 45-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over (US 6,205,437) Gifford in view of (US 6,338,046) Saari et al, hereafter Saari.

Claims 7 and 45. Gifford failed to disclose, wherein the processing engine is location independent and language independent. Saari discloses, wherein the processing engine is location independent and language independent (col. 8, lines 41-63). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the teachings of Saari into Gifford because such an incorporation would allow Gifford to have a flexible and ability to have a format that is language independent when processing records or files.

Claims 8 and 46. Gifford discloses, wherein the insertion of the record into the database and the application of the composition rule to the record occurs in real time (col. 7, lines 51-64).

Claims 9 and 47. Gifford discloses, wherein the storage of the record in the database and the application of the composition rule to the metric occurs in a single location (col. 8, lines 12-24).

Claims 10 and 48. Gifford failed to disclose, wherein a plurality of the records from a plurality of on demand services are collaborated, wherein collaboration involves the application of the composition rule to the plurality of records. Saari discloses, wherein a plurality of the records from a plurality of on demand services are collaborated, wherein



collaboration involves the application of the composition rule to the plurality of records (col. 7, lines 8-46)

Claims 11 and 49. Gifford discloses, wherein the record comprises: a fixed number of required fields and a variable number of attributes (col. 11, lines 32-55).

Claims 12 and 50. Gifford discloses, wherein the required fields comprise: a resource identification, a user identification, a measurement value, a unit of work identification, and a close unit of work flag (col. 8, lines 13-24).

Claims 13 and 51. Gifford discloses, wherein each attribute comprises a name and a value; wherein the name describes a type of attribute; and wherein the value is a measurement of the attribute (col. 8, lines 34-65).

Claims 14 and 52. Gifford failed to disclose, wherein the required fields are stored in a record table in the database; wherein the attributes are stored in an attribute table in the data; and wherein a key correlates the required fields to the attributes. Saari discloses, wherein the required fields are stored in a record table in the database; wherein the attributes are stored in an attribute table in the data; and wherein a key correlates the required fields to the attributes (col. 18, line 40-col. 19, line 23). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the teachings of Saari into Gifford because such an incorporation would allow Gifford to have a more efficient means of storing records and accessing the stored records.

Claims 15 and 53. Gifford failed to disclose, wherein the composition rules are created using a user friendly graphical user interface. Saari discloses, wherein the composition

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rules are created using a user friendly graphical user interface (col. 4, lines 3-17). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the teachings of Saari into Gifford because such an incorporation would allow Gifford to have an easy access to records through a graphical user interface.

Claim 39. Gifford discloses, A program product operable on a computer comprising: a computer-usable medium and wherein the computer usable medium comprises instructions for a computer to perform steps (col. 8, lines 8-11).

The method claims contain the similar elements as the program product claims and are thus rejected with the similar rationale.

Applicants' invention appears to be directed to a database and managing records using a rule and a metric. It is unclear how the metering of an on-demand utility environment according to the claim limitations is supposed to be the claimed the invention.

### ***Conclusion***

The following are suggested formats for either a Certificate of Mailing or Certificate of Transmission under 37 CFR 1.8(a). The certification may be included with all correspondence concerning this application or proceeding to establish a date of mailing or transmission under 37 CFR 1.8(a). Proper use of this procedure will result in such communication being considered as timely if the established date is within the required period for reply. The Certificate should be signed by the individual actually depositing or transmitting the correspondence or by an individual who, upon information and belief, expects the correspondence to be mailed or transmitted in the normal course of business by another no later than the date indicated.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Bodin et al (US 2005/0071462A1) disclosed using metric patterns.

Wan et al (US 6,728,703 B1) disclosed processing movement delta metrics.

Thomas et al (US 7,013,323) disclosed ecommerce metrics utilizing a list of rules.

### ***Inquiries***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 571-272-6741. The examiner can normally be reached on Monday, Wednesday, and Thursday, 5:30AM-3:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Dixon can be reached on 571-272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

January 28, 2008

/Ella Colbert/

Primary Examiner, Art Unit 3696